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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
6,705,701	10/26/83	HUSBANDS	[illegible]

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EXAMINER	
HAGAN	
ART UNIT	PAPER NUMBER
173	4

DATE MAILED: 11/05/84
04/05/84

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1-36 are pending in the application.
   Of the above, claims 34-36 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-33 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

PTOL-326 (Rev. 7-82) EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-33 , drawn to compounds , classified in Class 564 , subclass 336 and class 260, subclass 465.

II. Claim 34 , drawn to a cyano intermediate compound , classified in Class 260 , subclass 465 .

III. Claim 35 , drawn to an amide , classified in Class 564 , subclasses 165, 166 and 167 .

IV. Claim 36 , drawn to different processes of making compounds, classified in Class , subclass .

The inventions are separate and distinct, each from the other because of the following reasons:

Inventions II-III and I are related as mutually exclusive species in intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP section 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP section 806.04(h)).

In this instant case, the intermediate product is deemed to be useful as pesticides or as intermediates to make other compounds, such as phenyl and cycloalkanol substituted acetic acids and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should

applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Inventions IV and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case claim 36 evidences that the product as claimed can be made by materially different processes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and divergent fields of search restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Richard K. Jackson on October 11, 1984 a provisional election was made without traverse to prosecute the invention of I , claims 1-33 and the species recited in claim 4 . Affirmation of this election must be made by applicant

in responding to this Office action.

Claims 34-36 stand withdrawn from further consideration by the Examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention.

35 U.S.C. 101 reads as follows:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1-33 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2 of applicant's copending application serial no. 486,594 . This is a double patenting rejection.

Claims 1-3 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The specification fails to teach the preparation ~~fails to teach the preparation~~ of the compound wherein R_5, and/or R6 are cyano and/or nitro. The reduction of the intermediate, cyano or amido compounds will also reduce the cyano and nitro groups of R_5 and R_6.

The recitation of the dotted line to represent "optional unsaturation" is indefinite and broader than the scope of the enabling disclosure. It includes triple bonded moieties which are not intended.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Chan/kl
703/557-3920
11-3-84

NICKY CHAN
PRIMARY EXAMINER
ART UNIT 123